

REMARKS

Applicant has carefully studied the Office Action of October 14, 2005 and offers the following remarks to accompany the above amendments.

Before addressing the rejections, Applicant provides a brief summary of the present invention so that the remarks relating to the rejections are considered in the proper context. The present invention is a portable device that the user carries and selectively couples to a host computer. Once the portable device is coupled to the host computer, software applications are launched on the host computer as a function of automatically executing software on the portable device. One of the applications is a web browser. Another function of the present invention is to push content to the user. Content is provided to the user through an interface frame. The interface frame is similar to a "window" that is distinct from the browser, rides on top of the browser, and may lie on top of the normal task bar that is present at the top of a browser window (see Figs. 5 and 6). The interface frame has a spot in which the content can be displayed. Likewise, the browser displays other content like a conventional browser.

It is important to note that the present invention is designed to function independently of the current status of the computer. That is, the current invention allows the portable device to be inserted into the computer and automatically executes the software without requiring the computer to change states, and in particular, the present invention does not require the computer to boot or reboot. As booting the computer is a disruptive and time consuming process, the lack of a requirement to boot or reboot the computer provides an advantage over Paul, which explicitly requires booting the computer.

Claim 41 was rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicant respectfully traverses. In general, negative limitations are not ambiguous, and negative limitations are now an accepted form of claim drafting despite earlier concerns by the courts. MPEP § 2173.05(i). However, a negative limitation must have a basis in the original disclosure. *Id.*

The Patent Office objects to the "without requiring the host computing device to reboot" in claim 41, arguing that this negative limitation is not supported in the original disclosure. Applicant respectfully traverses. MPEP § 2173.05(i) goes on to state "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter.

1993).” Applicant notes that the specification never mentions rebooting the host computing device as a precondition to operation of the invention.

As noted above, rebooting the computer is a time consuming and disruptive process. It is not an operation that someone of ordinary skill in the art relishes or expects to have to perform. While certain MICROSOFT platform updates usually require rebooting to implement fully the update, such reboots are performed only after prompting the computer user. Thus, rebooting remains an exception to normal computing operations. This perception of a boot sequence is confirmed by Paul’s disclosure which stresses the need for a boot sequence to implement Paul’s invention.

Since Applicant’s specification does not mention a boot or reboot requirement, the person skilled in the art would interpret that absence to mean that such is not required. Rather, if a boot or reboot were required, someone skilled in the art would expect that fact to be highlighted as it is in Paul’s disclosure. Since Applicant does not require booting or rebooting, the absence of booting or rebooting is not explicitly set forth in the specification. However, 35 U.S.C. § 112 and MPEP § 2173.05(i) do not require every negative limitation to be set forth explicitly as noted above. Since booting and rebooting are the exceptions to the norm, the absence of a discussion of the boot requirements in Applicant’s specification indicates that Applicant’s invention functions normally and does not require a boot or reboot. In short, the negative limitation is supported in the specification. Applicant requests withdrawal of the § 112 rejection of claim 41 at this time.

Applicant further notes that there is clearly a difference between Applicant’s invention and Paul’s system with respect to this issue. Paul requires a boot sequence. Applicant does not. If the Patent Office has alternative language which captures this distinction and is better supported by the specification, Applicant requests that the Patent Office suggest language which captures this distinction. However, in the absence of better language from the Patent Office, the current language is properly supported and captures this distinction adequately.

Claims 9, 25, and 37 were rejected under 35 U.S.C. § 112 for having inadequate antecedent basis for “the banner”. Applicant herein amends the claims to provide the appropriate antecedent basis. Applicant requests withdrawal of the § 112 rejection of claims, 9, 25, and 37 at this time.

Claims 1, 5-7, 9, 12-15, 17, 21-23, 25, 28, 29, 33-35, 37, and 40 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Krishan et al. (hereinafter "Krishan"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is shown. MPEP § 2143.03.

Applicant is aware that most inventions are combinations of known elements. One of the things that makes an invention patentable is that there was no suggestion to combine the known elements in the manner claimed. To avoid impermissible hindsight reconstruction, the Federal Circuit, in *Dembiczak*, acknowledged earlier case law that set forth various sources from which a suggestion to combine references may come, but reiterated that the range of available sources does not diminish the requirement for actual evidence. *In re Dembiczak* at 999. In the present application, the Patent Office has not complied with the requirements set forth by the Federal Circuit. Specifically, the Patent Office asserts that the motivation to combine the references is "to enable Paul's system to display advertisements on user's screen." (Office Action of October 14, 2005, page 4, lines 14-15). This asserted motivation lacks the required actual evidence. Since the motivation lacks the required actual evidence, the motivation is improper. Since the motivation is improper, the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant further traverses the motivation to combine the references because the motivation does not suggest the combination. Specifically, Paul is a set top box for a television (see Paul Figure 1). Televisions almost always display advertisements. Certainly broadcast channels are replete with advertisements. Even cable channels such as HBO, CNN, and ESPN show advertisements. Thus, there is no need to add Krishan to Paul to allow Paul's system to display advertisements on the user's screens. Since the stated motivation does not suggest the combination, the combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant still further traverses the rejection because the Patent Office has not established *prima facie* obviousness. Specifically, the combination, even if proper, does not show an

interface *frame* as recited in the independent claims. The Patent Office asserts that Paul shows the interface frame at col. 3, lines 58-65. While the cited passage does use the word “interface”, this interface 22 is a PCMCIA/IDE card and is not actually present on the display. Nothing in this passage indicates that any sort of interface frame is present on the display as recited in the claims. Krishan does not cure the deficiencies of Paul. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection at this time.

Claims 11, 27, and 39 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul, Kirshan and Hendrick. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because, as explained above, Paul and Krishan do not support the rejection of the independent claims. Hendrick does not cure these problems, and thus, the claims are allowable.

Applicant further traverses the rejection because the Patent Office has not properly supported the motivation to combine Hendrick with the other references. Specifically, the Patent Office asserts the motivation is “to prevent the fraudulent use of the configuration card.” (Office Action of October 14, 2005, page 5, lines 15-16). This asserted motivation lacks the evidence required by the Federal Circuit and is improper. Since the motivation is improper, the combination is improper, and the claims are allowable.

Claim 41 is also addressed in this section, although it is not specifically rejected. Applicant further notes that the language that the Patent Office uses in its rejection is the “independent of a boot state” language which has been deleted by the previous amendment. Applicant still further notes that the combination of Hendricks’ “independent of a boot state” operation with Paul changes Paul’s principle of operation, since Paul requires a boot operation. Since changing a principle of operation is strong evidence of non-obviousness, the combination is non-obvious. MPEP § 2143.01.

Claims 2-4, 18-20, and 30-32 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul, Krishan, and Suga et al. (hereinafter “Suga”). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant traverses the rejection because, as explained above, Paul and Krishan do not support the rejection of the independent claims. Suga does not cure these problems, and thus, the claims are allowable.

Claim 16 was rejected under 35 U.S.C. § 103 as being unpatentable over Paul, Krishan, and Yee et al. (hereinafter "Yec"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

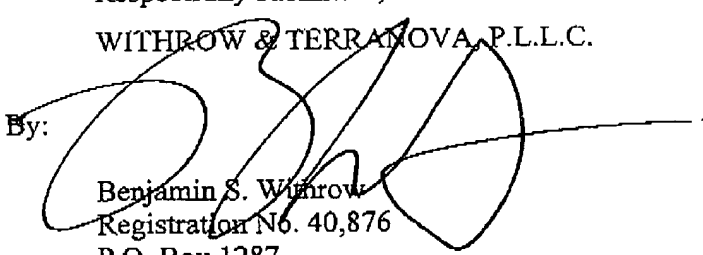
Applicant traverses the rejection because, as explained above, Paul and Krishan do not support the rejection of the independent claims. Hendrick does not cure these problems, and thus, the claims are allowable.

Applicant requests reconsideration of the rejections in light of the remarks and amendments presented herein. The references are not properly combined and do not teach the interface frame recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest opportunity.

Respectfully submitted,

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